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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,529	07/24/2000	PATRICIA KANNOUCHE	192863US0PCT	6934

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EXAMINER

JOHANNSEN, DIANA B

ART UNIT PAPER NUMBER

1634

DATE MAILED: 07/08/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/555,529

Applicant(s)

KANNOUCHE ET AL.

Examiner

Diana Johannsen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Election/Restriction

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-5, 24-25, and 29, drawn to nucleic acids encoding proteins and fragments thereof, including expression vectors, and nucleic acid detection reagents.

Group II, claim(s) 6-12, drawn to methods for detecting nucleic acids.

Group III, claim(s) 13-15 and 18-19, drawn to proteins.

Group IV, claim(s) 16-17, drawn to antisense oligonucleotides.

Group V, claim(s) 20-23, drawn to methods for preparing medicinal products using proteins or protein fragments.

Group VI, claim(s) 26, drawn to methods for preparing medicinal products using expression vectors.

Group VII, claim(s) 27, drawn to methods of detecting DNA repair using expression vectors.

Group VIII, claim(s) 28, drawn to methods of regulating the "protein-curved DNA interaction" using a protein fragment.

2. The inventions listed as Groups I-VIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons.

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3. Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features. The expression "special technical feature" is defined in PCT Rule 13.2 as meaning those technical features that define a contribution that an invention considered as a whole makes over the art. Regarding the relationship of Group I with Groups II-VIII, a shared technical feature is present in that nucleic acids encompassed by Group I may be employed in the methods of Group II, VI, and VII, may encode proteins encompassed by and employed in Groups III, V, and VIII, and may be modified, e.g., truncated, to produce the antisense molecules of Group IV. However, the prior art as exemplified by Kannouche et al (Biochimie 79(9-10):599-606 [10/1997]) discloses nucleic acids meeting the requirements of Group I. Accordingly, the nucleic acids of Group I cannot constitute a special technical feature as defined by PCT Rule 13.2, and unity of invention is therefore lacking.

4. Further, Groups I-VIII do not share another technical feature that might constitute a "special technical feature" as defined by PCT Rule 13.2. The proteins of Group III, which are composed of amino acids and employed in, e.g., methods of making antibodies and/or methods requiring protein/antibody binding, are structurally and functionally distinct from the antisense nucleic acids of Group IV, which are composed of nucleotides and employed in, e.g., methods of regulating expression. The methods of Groups II and V-VIII each have different objectives and/or require the use of different sets of reagents and different steps. The method of Group II requires steps of, e.g., hybridization, to achieve the objective of nucleic acid detection. The method of Group V

requires the use of protein in preparation of a medicinal product, while Group VIII requires the use of protein in regulating "protein-DNA curved" interactions. The method of Group VI requires the use of a vector in preparation of a medicinal product, while Group VII requires the use of a vector in detection of, e.g., DNA repair progression. Thus, the inventions of Groups I-VIII are not so linked by a special technical feature within the meaning of PCT Rule 13.2 so as to form a single general inventive concept.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diana B. Johannsen whose telephone number is 703/305-0761. The examiner can normally be reached on Monday-Friday, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on 703/308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are 703/872-9306 for regular communications and 703/872-9307 for After Final communications.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-0196.

Diana B. Johannsen
June 27, 2002



W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600